

## REMARKS/ARGUMENTS

Responsive to the Office Action mailed November 14, 2007:

- A. The Office Action rejected claims 12-16 under 35 USC 102(b) as being anticipated by Setlak (US 5,963,679). Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.<sup>1</sup> "For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review."<sup>2</sup>

As to amended claim 12, Setlak '679 does not disclose: that the law of variation is related to the element carrying the fingerprint. The Examiner considers that a law is disclosed in this document. If such a law exists in this document, this law is only a general law which is applicable to all fingers which is not related to the analyzed finger.

As discussed in paragraph [0027] and paragraph [0028] of the published application for the present application, the graph and the law represent the variation of the impedance in relation with the surface S at the moment t when the measurement has been done. This phenomenon is due to the variations of the environment or of the finger. But under fixed conditions, the same finger will always give the same graph.

This law is established between the surface C and the impedance Z for a given finger. Setlak does not disclose this principle.

Claim 12 is therefore allowable.

Claims 13-16 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

- B. The Office Action rejected claims 17, 18 and 22 under 35 USC 103(a) as being unpatentable over Setlak (US 6,067,368).

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<sup>1</sup> *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

<sup>2</sup> *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>3</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>4</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>5</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach or suggest all the claim limitations.

As to claim 17, the cited prior art does not disclose: that the law of variation is related to the element carrying the fingerprint. Setlak '368 does not disclose that a law used in the sensor is related to the analyzed finger.

Claim 17 is therefore allowable. Claims 18 and 22 contain additional elements or limitations beyond allowable claim 17 and are also allowable.

- C. The Office Action rejected claims 19-21 under 35 USC 103(a) as being unpatentable over Hestes (US6,778,686 in combination with Setlak (US 5,943,441).

Hestnes does not disclose that a law used in the sensor is related to the analyzed finger. Setlak '441 discloses a fingerprint sensor comprising a system which measures the complex impedance of the finger. From this measurement, the sensor can deduce if the finger is alive or

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<sup>3</sup>MPEP Sec. 2142.

<sup>4</sup> Id.

<sup>5</sup>Id. (emphasis supplied)

not. The decision is based on the value of the angle of the impedance. The range is the same for all the fingers and is not related to the analyzed finger.

Claims 19, 20, and 21 are therefore allowable.

- D. The prior art made of record and not relied upon that is considered pertinent to applicant's disclosure.

This prior art has not been cited against any of the claims and is therefore not discussed in this Amendment and Response.

- E. The Examiner has not applied the test of *Graham v. John Deere Co.*<sup>6</sup> The MPEP requires the Examiner to do so.<sup>7</sup> However, the Examiner has made no finding of the level of ordinary skill in the art.<sup>8</sup>


The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.<sup>9</sup> This is especially so when the factfinder makes conclusory statements that "'do not fulfill the agency's obligation' to explain all material facts relating to a motivation to combine."<sup>10</sup>

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Dated: 14 Feb 08

Respectfully submitted,

By   
Gerald E. Helget (Reg. No. 30,948)  
Nelson R. Capes (Reg. No. 37,106)  
BRIGGS AND MORGAN, P.A.  
2200 IDS Center, 80 South Eighth Street  
Minneapolis, MN 55402  
Telephone: 612-977-8480  
Facsimile: 612-977-8650

<sup>6</sup> 383 U.S. 1 (1966)

<sup>7</sup> MPEP § 2141

<sup>8</sup> MPEP § 2141.03

<sup>9</sup> *Dystar*, 464 F.3d 1366 and cases cited therein.

<sup>10</sup> *Id.*